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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Baxter et al.

Serial No: 09/977,096

Filed: October 12, 2001

For: Mediators of Hedgehog Signaling
Pathways, Compositions and Uses
Related Thereto

Attorney Docket No. CIBT-P02-105

Art Unit: 1614

Examiner: Kim, Vickie Y.

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to: Commissioner for Patents Washington, D.C. 20231 on the date indicated below:

December 30, 2002
Date of Signature
and of Mail Deposit

Mary Jane DiPalma

Commissioner of Patents
Washington, D.C. 20231

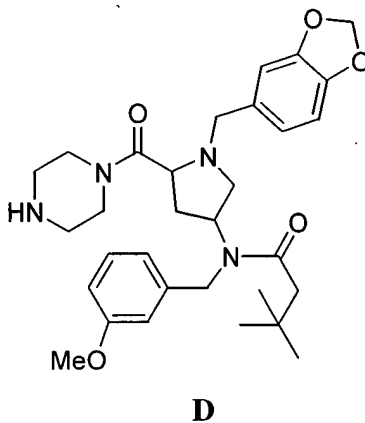
REPLY TO RESTRICTION REQUIREMENT

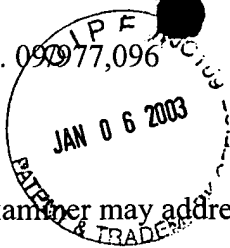
Sir:

In reply to the outstanding Restriction Requirement, mailed October 8, 2002, in connection with the above application, Applicants hereby elect Group II, claims 17-31, drawn to a pharmaceutical formulation comprising an aqueous solution of a pharmaceutically acceptable salt of a compound of formula II, classified in class 514, subclass various. Applicants elect this invention with traverse, because Group VII, claims 36-46, drawn to a pharmaceutical formulation comprising an aqueous solution of a pharmaceutically acceptable salt of a compound of formula III and Group VIII, claims 47-58, drawn to a pharmaceutical formulation comprising an aqueous solution of a pharmaceutically acceptable salt of a compound of formula IV are entirely within the scope of Group II (wherein s = 0, q = 1, and r = 1), and thus a search of Group II necessarily entails a search of the entire scope of Groups VII and VIII. Accordingly, all three groups could be examined simultaneously without any additional burden.

Furthermore, the claims of Groups IV, V, and VI, respectively claims 33, 34, and 35 (incorrectly identified in Paper No. 7 as claims 32, 33, and 34), and Groups VIII [sic.], X, XI, and XII, respectively claims 59, 60, 61, and 62, depend upon the claims of Group II, VII, or VIII and contain all the limitations thereof. Applicants respectfully direct the Examiner's attention to MPEP 809, which states that upon allowance of a generic linking claim, "[a]ny claim(s) directed to the nonelected invention(s), previously withdrawn from consideration, which depends from or includes all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability." In addition, "[w]hen a generic claim is subsequently found to be allowable, and not more than a reasonable number of additional species are claimed, . . . when *all* claims to each of the additional species are embraced by an allowable generic claim as provided by 37 CFR 1.141, applicant must be advised of the allowable generic claim and that claims drawn to the nonelected species are no longer withdrawn since they are fully embraced by the allowed generic claim." (MPEP 809.02(c)(B)(1)) (emphasis in original).

In response to the requirement that Applicants elect a single disclosed species, Applicants elect compound **D** of Figure 32a with traverse and for search purposes only.





REMARKS

The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

Date: December 30, 2002

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Respectfully Submitted,

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